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EXAMINER

HASHEM, LISA

ART UNIT PAPER NUMBER

2645

DATE MAILED: 08/12/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/930,229

Applicant(s)

FORBES, LEONARD

Examiner

Lisa Hashem

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/2-7-02</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

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### **DETAILED ACTION**

1. Claims 1-53 are pending in this office action.

#### ***Information Disclosure Statement***

2. An initialed and dated copy of Applicant's IDS form 1449, Paper No. 3, is attached to the instant office action.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 3, 16, 25, and 39 recite the limitation "the frequency" in pages 12, 14, 17, and 19.

There is insufficient antecedent basis for this limitation in the claim.

5. Claims 5, 18, 27, and 41 recite the limitation "the vicinity" in pages 13, 15, 17, and 19.

There is insufficient antecedent basis for this limitation in the claim.

#### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-6, 8-9, 12-19, 22-30, 36-41, 44-47, and 49-52 are rejected under 35

U.S.C. 102(e) as being clearly anticipated by U.S. Patent Application No. US 2001/0049262 by Lehtonen.

Regarding claim 1, Lehtonen discloses a portable memory module (see Figure 3, 21) comprising: at least one memory device (Figure 3: 21, Memory); a transmitter/receiver circuit for (i) wirelessly receiving data communicated to said module and (ii) wirelessly transmitting data from said module (Figure 3: 21, BT2); and a controller (Figure 3: 21, 27) in communication with said at least one memory device and said transmitter/receiver circuit for storing data in said memory device received by said transmitter/receiver circuit and for returning data from said memory device for transmission by said transmitter/receiver circuit from said module (page 1: section 0013, line 1 – section 0014, line 8; page 2: section 0030, line 1 – section 0032, line 4; page 5, section 0052, lines 1-13).

Regarding claim 2, a memory module according to claim 1, wherein Lehtonen further discloses said wireless transmission and reception uses radio waves (page 1: section 0014, lines 8-11; page 2, section 0027, lines 5-9).

Regarding claim 3, a memory module according to claim 2, wherein Lehtonen further discloses a frequency of said radio waves is in the range of about 900 MHz to about 10 GHz (page 2, section 0032, lines 1-4).

Regarding claim 4, a memory module according to claim 2, wherein Lehtonen further discloses said radio waves are Bluetooth<sup>TM</sup> compliant radio waves (page 2, section 0027, lines 5-9; page 2, section 0032, lines 1-4).

Regarding claim 5, a memory module according to claim 2, wherein Lehtonen further discloses said transmitter/receiver automatically establishes a radio wave communications path when in a vicinity of another transmitter/receiver (Figure 3: 22, BT), which transmits data to or

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receives data from said module (page 2: section 0031, line 6 – section 0032, line 7; page 3, section 0040, lines 1-9).

Regarding claim 6, a memory module according to claim 3, wherein Lehtonen further discloses said frequency is about 2.4 GHz (page 2, section 0032, lines 1-4).

Regarding claim 8, a memory module according to claim 1, wherein Lehtonen further discloses a self-contained electrical power supply unit at said module for providing operating power to electrical components at said module (page 2, section 0019, lines 3-8; page 2, section 0032, lines 7-9).

Regarding claim 9, a memory module according to claim 8, wherein Lehtonen further discloses said power supply unit comprises at least one battery (page 2, section 0019, lines 3-8; page 2, section 0032, lines 7-9).

Regarding claim 12, a memory module according to claim 1, wherein Lehtonen further discloses said memory device inherently comprises a dynamic random access memory device or memory card (page 1, section 0014, lines 1-8).

Regarding claim 13, a memory module according to claim 1, wherein Lehtonen further discloses said memory device inherently comprises a flash memory or fixed memory device (page 1, section 0014, lines 1-8).

Regarding claim 14, Lehtonen discloses a processor system (Figure 3, 22) for communicating with a portable memory module (Figure 3, 21), said processor system comprising: at least one memory device (Figure 3: 22, MEM); a transmitter/receiver circuit for (i) wirelessly receiving data communicated to said system and (ii) wirelessly transmitting data from said system (Figure 3: 22, BT); and a controller (Figure 3: 22, MPU) in communication

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with said at least one memory device and said transmitter/receiver circuit for storing data in said memory device received by said transmitter/receiver circuit and for returning data from said memory device for transmission by said transmitter/receiver circuit from said system (page 3, section 0035, lines 1-23; page 5, section 0052, lines 1-13).

Regarding claim 15, a processor system according to claim 14, wherein Lehtonen further discloses said wireless transmission and reception uses radio waves (page 2, section 0027, lines 5-9; page 3, section 0035, lines 1-6).

Regarding claim 16, a processor system according to claim 15, wherein Lehtonen further discloses a frequency of said radio waves is in the range of about 900 MHz to about 10 GHz (page 3, section 0035, lines 19-22).

Regarding claim 17, a processor system according to claim 15, wherein Lehtonen further discloses said radio waves are Bluetooth<sup>TM</sup> compliant radio waves (page 2, section 0027, lines 5-9; page 3, section 0035, lines 1-6).

Regarding claim 18, a processor system according to claim 15, wherein Lehtonen further discloses said transmitter/receiver automatically establishes a radio wave communications path when in a vicinity of another transmitter/receiver which transmits data to or receives data from said system (page 3: section 0035, lines 1-6 and section 0040, lines 1-9).

Regarding claim 19, a processor system according to claim 16, wherein Lehtonen further discloses said frequency is about 2.4 GHz (page 3, section 0035, lines 19-22).

Regarding claim 22, please see the rejections of the memory module and processor system in claims 1 and 14 above, to reject the system to claim 22.

Regarding claim 23, a system for the portable transfer of data according to claim 22, wherein Lehtonen further discloses said portable data transfer system further comprising: a second processor system or base station inherently comprising: at least one second processor system memory device; a second processor system transmitter/receiver circuit for (i) wirelessly receiving data communicated to said second processor system and (ii) wirelessly transmitting data from said second processor system; and a second processor system controller in communication with said at least one second processor system memory device and said second processor system transmitter/receiver circuit for storing data in said memory device received by said transmitter/receiver circuit and for returning data from said memory device for transmission by said transmitter/receiver circuit from said second processor system (page 3: section 0035, lines 10-14 and section 0040, lines 1-9; page 4, section 0045, lines 4-19).

Regarding claim 24, please see the rejections of the memory module and processor system in claims 2 and 15 above, to reject the system to claim 24.

Regarding claim 25, please see the rejections of the memory module and processor system in claims 3 and 16 above, to reject the system to claim 25.

Regarding claim 26, please see the rejections of the memory module and processor system in claims 4 and 17 above, to reject the system to claim 26.

Regarding claim 27, a system for the portable transfer of data according to claim 22, wherein Lehtonen further discloses said first processor system transmitter/receiver, said memory module transmitter/receiver and said second processor system transmitter/receiver automatically establish a radio wave communications path when in a vicinity of another transmitter/receiver

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which transmits or receives data (page 3: section 0035, lines 10-14 and section 0040, lines 1-9; page 4, section 0045, lines 4-19).

Regarding claim 28, please see the rejections of the memory module and processor system in claims 6 and 19 above, to reject the system to claim 28.

Regarding claims 29-30, please see the rejections of the memory module in claims 8-9 above, to reject the system to claims 29-30.

Regarding claims 36 and 37, please see the rejections of the system in claim 22 above, to reject the method in claims 36 and 37.

Regarding claims 38-41, please see the rejections of the system in claims 24-27 above, respectively, to reject the method in claims 38-41.

Regarding claims 44-47 and 49-52, please see the rejections to the memory module in claims 1, 8, 2, and 4 mentioned above, respectively, to reject the memory module in claims 44-47 and 49-52.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 2001/0049262 by Lehtonen as applied to claim 1 above, and in further view of U.S. Patent No. 6,259,405 by Stewart et al, hereinafter Stewart.



Regarding claim 7, a memory module according to claim 1, wherein Lehtonen further discloses said wireless transmission and reception uses radio waves (page 1: section 0014, lines 8-11; page 2, section 0027, lines 5-9).

Lehtonen does not disclose said wireless transmission and reception uses light waves.

Stewart discloses a portable computing device or PCD (see Abstract; Figure 1A, 110A) inherently comprising: at least one memory device; a transmitter/receiver circuit for (i) wirelessly receiving data communicated to said module and (ii) wirelessly transmitting data from said module; and a controller in communication with said at least one memory device and said transmitter/receiver circuit for storing data in said memory device received by said transmitter/receiver circuit and for returning data from said memory device for transmission by said transmitter/receiver circuit from said module (column 11, lines 9-20).

Stewart further discloses said wireless transmission and reception inherently uses light waves (column 6, lines 39-49; column 8, lines 33-47).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the memory module of Lehtonen to include a wireless transmission and reception uses light waves as taught by Stewart to provide wireless communication accomplished through infrared. One of ordinary skill in the art would have been lead to make such a modification since infrared communication technologies allow remote wireless communication to and from the PCD.

10. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2001/0049262 by Lehtonen as applied to claim 1 above, and in further view of U.S. Patent No. 4,143,417 by Wald et al, hereinafter Wald.

Regarding claims 10 and 11, a memory module according to claim 9, wherein Lehtonen does not disclose said at least one battery is rechargeable and said power supply unit further comprising terminals for communicating with a recharger for recharging said at least one rechargeable battery.

Wald discloses a portable memory module or hand held unit (see Abstract; Figure 1, 110) inherently comprising: at least one memory device; and a controller in communication with said at least one memory device for storing data in said memory device and for returning data from said memory device (column 2, line 61 – column 3, line 41).

Wald further discloses a self-contained electrical power supply unit (Figure 1, 140; Figure 2, 140) at said module for providing operating power to electrical components at said module, wherein said power supply unit comprises at least one battery that is rechargeable (Figure 2, 204). Said power supply unit further comprising terminals for communicating with a recharger or charge circuit (Figure 4, 430) for recharging said at least one rechargeable battery (column 6, lines 34-68).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the memory module of Lehtonen to include a rechargeable battery and a recharger as taught by Wald to provide power to the memory module. One of ordinary skill in the art would have been lead to make such a modification since the power supply unit can be recharged.

11. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 2001/0049262 by Lehtonen as applied to claim 14 above, and in further view of U.S. Patent No. 6,259,405 by Stewart.

Regarding claim 20, a processor system according to claim 14, wherein Lehtonen further discloses said wireless transmission and reception uses radio waves (page 2, section 0027, lines 5-9; page 3, section 0035, lines 1-6).

Lehtonen does not disclose said wireless transmission and reception uses light waves.

Stewart discloses a processor system or wireless access point in a geographic based communications service system (see Abstract; Figure 1A, 120) for communicating with a portable computing device or PCD (Figure 1A, 110A), said wireless access point inherently comprising: at least one memory device; a transmitter/receiver circuit for (i) wirelessly receiving data communicated to said system and (ii) wirelessly transmitting data from said system; and a controller in communication with said at least one memory device and said transmitter/receiver circuit for storing data in said memory device received by said transmitter/receiver circuit and for returning data from said memory device for transmission by said transmitter/receiver circuit from said system (column 7, line 51 – column 8, line 47).

Stewart further discloses said wireless transmission and reception inherently uses light waves (column 6, lines 39-49; column 8, lines 33-47).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the processor system of Lehtonen to include a wireless transmission and reception uses light waves as taught by Stewart to provide wireless communication accomplished through infrared. One of ordinary skill in the art would have been lead to make such a modification since infrared communication technologies allow remote wireless communication to and from the processor system.

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12. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 2001/0049262 by Lehtonen as applied to claim 14 above, and in further view of U.S. Patent No. 4,143,417 by Wald.

Regarding claim 21, a processor system according to claim 14, wherein Lehtonen does not disclose a recharger for providing operating power to electrical components of said module.

Wald discloses a processor system or service module (see Abstract; Figure 1, 120) for communicating with a portable memory module or hand held unit via a wired connection (Figure 1, 110).

Wald further discloses the service module comprising a recharger or charge circuit (Figure 4, 430) for providing operating power to electrical components of said hand held unit (column 6, lines 34-68).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the processor system of Lehtonen to include a recharger as taught by Wald to provide power to the portable memory module. One of ordinary skill in the art would have been lead to make such a modification since the recharger can provide power to the portable memory module when the power supply of the portable memory module is low.

13. Claims 31, 32, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2001/0049262 by Lehtonen as applied to claim 22 above, and in further view of U.S. Patent No. 4,143,417 by Wald.

Regarding claims 31, 32, and 34, please see the rejections to the memory module and processor system in claims 10, 11, and 21, respectively, to reject the system for the portable transfer of data in claims 31, 32, and 34.

14. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 2001/0049262 by Lehtonen in view of U.S. Patent No. 4,143,417 by Wald, as applied to claim 32 above, and in further view of U.S. Patent No. 6,031,353 by Banyas et al, hereinafter Banyas.

Regarding claim 33, a system for the portable transfer of data according to claim 32, wherein Lehtonen in view Wald do not disclose said recharger is a stand-alone recharger.

Banyas discloses a wireless communications device, such as a cellular telephone (Figure 1, 10), wherein said device further comprises a self-contained electrical power supply unit at said module for providing operating power to electrical components at said device; said power supply unit comprises at least one battery charging circuit (Figure 1, 18); said at least one circuit is rechargeable; said power supply unit further comprising terminals (Figure 1: 22, 24, 26) for communicating with a recharger for recharging said at least one rechargeable circuit; and wherein said recharger is a stand-alone recharger (Figure 1, 100; column 2, line 44 – column 3, line 7; column 3, lines 38-48; column 5, lines 8-26).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Lehtonen in view Wald to include a stand-alone recharger as taught by Banyas to provide power to the portable memory module. One of ordinary skill in the art would have been lead to make such a modification since the stand-alone recharger can provide power to the portable memory module when the power supply of the portable memory module is low.

15. Claims 35 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2001/0049262 by Lehtonen as applied to claim 32 above, and in further view of U.S. Patent No. 6,259,405 by Stewart.

Regarding claim 35, please see the rejections of the memory module and processor system in claims 7 and 20 mentioned above, to reject the system for the portable transfer of data in claim 35.

Regarding claim 42, a system according to claim 35, wherein Stewart further discloses said frequency is about 2.4 GHz (column 6, lines 39-45).

16. Claims 43, 48, and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2001/0049262 by Lehtonen as applied to claims 36, 44, and 49 above, respectively, and in further view of U.S. Patent No. 6,259,405 by Stewart.

Regarding claim 43, please see the rejection to the portable transfer of data in claim 35, to reject the method of portable data transfer in claim 43.

Regarding claim 48, please see the rejection to the memory module in claim 7, to reject the portable memory module in claim 48.

Regarding claim 53, please see the rejection to the memory module in claim 7, to reject the portable memory module in claim 53.

### ***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- U.S. Patent No. 5,493,665 by Eisenberg discloses a portable memory device comprising: at least one memory device; a transmitter/receiver circuit for (i) wirelessly receiving data communicated to said module and (ii) wirelessly transmitting data from said module; and a controller in communication with said at least one memory device and said transmitter/receiver circuit for storing data in said memory device received by said

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transmitter/receiver circuit and for returning data from said memory device for  
transmission by said transmitter/receiver circuit from said module

18. Any response to this action should be mailed to:

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Washington, D.C. 20231

**Or faxed to:**

(703) 872-9314 (for formal communications intended for entry)

**Or call:**

(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to: Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (703) 305-4302. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

LH

lh

August 2, 2004

FAN TSANG  
SUPERVISORY PATENT EXAMINER  
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